REMARKS

Status of Claims:

Claims 10-24 are present for examination.

Claim Rejection:

Claims 10-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Vargas (U.S. 2002/0046187). The rejection is respectfully traversed.

Submitted herewith is a declaration by the inventor under 37 C.F.R. §1.131 establishing that the subject matter presently claimed was conceived prior to the effective filing date of Vargas, and that there was diligence from before the effective filing date of Vargas through constructive reduction to practice. MPEP 715. Also submitted herewith is a translator's declaration attesting to the accuracy of translated documents that accompany the declaration.

Dates of Vargas and the present application

Vargas is based on a provisional application filed on March 31, 2000. In order to traverse Vargas as prior art under §102(e), applicant must show that the subject matter of the present claims was conceived prior to March 31, 2000, and must further show that applicant was diligent in reducing the invention to practice, beginning from a date prior to March 31, 2000. In this case, applicant has perfected its priority claim to Japanese application 2000-129065, filed April 28, 2000. The Japanese application is a constructive reduction to practice. Therefore applicant must show that it was diligent in preparing the Japanese patent application, beginning from a date prior to March 31, 2000.

Applicant notes that while this reply assumes the March 31, 2000 effective filing date of the Vargas application, Applicant does not waive the option of arguing further that the provisional application from which Vargas claims priority does not contain essential subject matter found in the Vargas reference, such that Vargas would not be entitled to the March 31, 2000 date as a §102(e) reference against the present claims.

Location

The invention was conceived and constructively reduced to practice in Japan, which is a WTO member country. MPEP 715.07(c)

Conception of the subject matter of the claims prior to March 31, 2000

The §1.131 declaration submitted herewith includes, as Exhibit A, a copy of an invention disclosure prepared by the inventor of the present application, dated March 13, 2000. The invention disclosure includes a draft patent application. An English language translation of Exhibit A is provided as Exhibit B.

Inspection of Exhibit B shows that the inventor conceived of all features now claimed at least as early as March 13, 2000. The following shows that all features of all claims presented in the application were documented in the draft application of Exhibit B.

Claim 10 Feature	Documented:
10. (Previously Presented) A system, comprising:	
an application service provider server, said application service provider server including a storage device;	Figure 2 shows the ASP server 240. Page 15, lines 16-17 states that information is stored at the ASP server.
a candidate enterprise terminal, said candidate enterprise terminal connected to said application service provider server by a communication network,	Figure 2 shows candidate enterprise terminals 210, 220, 230 connected to a network 250 to which the ASP server 240 is also connected.
said candidate enterprise terminal being configured to transmit at least non-public business information to said application service provider server, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise,	Figure 4, items B1, B2 and B3, show candidate enterprise terminals 210, 220, 230 transmitting general business activities such as financial, accounting, marketing and manufacturing information to ASP server 240. Page 6, lines 24-28, state that a tax report is a type of document obtained from a candidate enterprise. Page 11, line 18 – page 12, line 3 state that a problem to be solved by the invention is to provide this information without disclosing the information publicly (see page 12, line 1).
said application service provider server being configured to store said non-public business information in said storage device; and	Figure 4, items B1, B2 and B3, state that the general business activities such as financial, accounting, marketing and manufacturing information are "recorded on" the ASP server 240.

a merger and acquisition brokering business entity terminal, said merger and acquisition brokering business entity terminal connected to said application service provider server by said communication network,	Figure 2 shows a merger and acquisition brokering business entity terminal 200 connected to a network 250 to which the ASP server 240 is also connected.
said merger and acquisition brokering business entity terminal being configured to obtain said non-public business information from said application service provider server,	Figure 4, item B7, shows merger and acquisition brokering business entity terminal 200 acquiring the general business activities (*i.e.*, financial, accounting, marketing and manufacturing information) from the ASP server 240.
said merger and acquisition brokering business entity terminal being further configured to generate a merger or acquisition proposal based on said non-public business information,	Figure 4, item B7, shows merger and acquisition brokering business entity terminal 200 analyzing the general business activities (*i.e.*, financial, accounting, marketing and manufacturing information) obtained from the ASP server 240 and generating a merger and acquisition proposal.
said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise.	Page 5, lines 26-27 states that data obtained from the ASP server is analyzed so as to generate a merger and acquisition proposal.

Claim 11 specifies that the system of claim 10 includes a second candidate enterprise terminal that has the same features as the first candidate enterprise terminal, and that the merger and acquisition brokering business entity terminal operates in the same manner with respect to the second candidate enterprise terminal as with the first candidate enterprise terminal. Figures 2 and 3 show multiple candidate enterprise terminals having these features.

Claim 12 specifies that the candidate enterprise terminal transmits updated non-public business information at specified times. Page 14, lines 4-10 specify that the candidate enterprise terminal has a function for updating information provided to the ASP server.

Claim 13 specifies that the communication network is the Internet. Page 16, lines 28-29 specify that the network is the Internet.

Claim 14 specifies that the application service provider server, the candidate enterprise terminal, and the merger and acquisition brokering business entity terminals are computers. Figure 2 shows the candidate enterprise terminals as computer terminals connected to a network.

Claim 15 specifies that the non-public business information has not been made public. Page 11, line 18 – page 12, line 3 state that a problem to be solved by the invention is to provide this information without disclosing the information publicly (see page 12, line 1).

Claim 16 Feature	Documented:
16. (Previously Presented) A method, comprising:	
sending at least non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise;	Figure 4, items B1, B2 and B3, show candidate enterprise terminals 210, 220, 230 transmitting general business activities such as financial, accounting, marketing and manufacturing information to ASP server 240. Figure 3 shows that the information is transmitted through a network 250. Page 6, lines 24-28, state that a tax report is a type of document obtained from a candidate enterprise. Page 11, line 18 – page 12, line 3 state that a problem to be solved by the invention is to provide this information without disclosing the information publicly (see page 12, line 1).
storing, by said application service provider server, said non-public business information;	Figure 4, items B1, B2 and B3, state that the general business activities such as financial, accounting, marketing and manufacturing information are "recorded on" the ASP server 240.
sending said non-public business information from said application service provider server to a merger and acquisition brokering business entity terminal over said communication network in response to a request from said merger and acquisition brokering business entity terminal; and	Figure 4, item B7, shows merger and acquisition brokering business entity terminal 200 acquiring the general business activities (*i.e.*, financial, accounting, marketing and manufacturing information) from the ASP server 240 in response to a request. Figure 3 shows that the information is transmitted through the network 250.
generating, by said merger and acquisition brokering business entity terminal, a merger or acquisition proposal based on said non-public business information, said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise.	Figure 4, item B7, shows merger and acquisition brokering business entity terminal 200 analyzing the general business activities (*i.e.*, financial, accounting, marketing and manufacturing information) obtained from the ASP server 240 and generating a merger and acquisition proposal. Page 5, lines 26-27 states that data obtained from the ASP server is analyzed so as to generate a merger and acquisition proposal.

Claim 17 specifies that the merger or acquisition proposal is sent from the merger and acquisition brokering business entity terminal to the candidate enterprise terminal. Page 5, lines 26-27 states that data obtained from the ASP server is analyzed so as to generate a merger and acquisition proposal, which is then naturally sent to the candidate enterprise.

Claim 18 specifies that the method further includes a second candidate enterprise terminal that interacts with the merger and acquisition brokering business entity terminal and the application service provider service in the same manner as the first candidate enterprise terminal. Figures 2 and 3 show multiple candidate enterprise terminals having these features.

Claim 19 specifies that non-public business information is sent from the candidate enterprise terminal periodically. Page 14, lines 4-10 specify that the candidate enterprise terminal has a function for updating information provided to the ASP server.

Claim 20 specifies that the communication network is the Internet. Page 16, lines 28-29 specify that the network is the Internet.

Claim 21 specifies that the application service provider server, the candidate enterprise terminal, and the merger and acquisition brokering business entity terminals are computers. Figure 2 shows the candidate enterprise terminals as computer terminals connected to a network.

Claim 22 specifies that the non-public business information has not been made public. Page 11, line 18 – page 12, line 3 state that a problem to be solved by the invention is to provide this information without disclosing the information publicly (see page 12, line 1).

Claims 23 and 24 specify a storage medium that stores programming for performing processing in a merger and acquisition brokering business entity computer of the type shown in Figure 4. This is naturally contemplated by the use of a computer to perform the specified processing.

Thus all claims of the present application were conceived at least as early as the March 13, 2000 date of the draft application. MPEP 715.07

Diligence

Exhibits A and B show that the inventor's disclosure and draft specification were submitted to the inventor's employer NEC Corporation on March 13, 2000.

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The §1.131 declaration submitted herewith further includes, as Exhibit C, a copy of a request sent on behalf of Mr. Naoki Kyamoto, Head of the Intellectual Property Department of NEC Corporation, to Mr. Yasuyuki Hata of the Saito & Hata International Patent Office. An English language translation of the request is provided as Exhibit D. The request instructs Mr. Hata to prepare and file a new patent application based on the draft patent application prepared by the inventor. The request was sent on March 31, 2000.

The §1.131 declaration shows at Par. 8 that the inventor worked diligently with Saito & Hata to prepare an application for filing at the Japanese Patent Office. The work included: expansion of the section describing means for solving the problem presented; addition of a section describing the mode of operation; expansion of the description of preferred embodiments, including the addition of a new embodiment (described at pages 21-24 of the English translation of Exhibit B) and corresponding new Figure 5; revision of the claims from an initial set of two claims to a final set of nine claims; and various additional revisions throughout the application.

The resulting Japanese application was filed on April 28, 2000. A copy of the Japanese application is attached to the §1.131 declaration as Exhibit E, and an English language translation of the Japanese application is attached as Exhibit F.

The §1.131 declaration and its Exhibits show that the inventor was diligent in preparing the Japanese application, beginning at least as early as March 13, 2000, prior to the March 31, 2000 filing of the Vargas provisional application. MPEP 715.07(a).

<u>The Japanese application is a constructive reduction to practice</u>

While many additions and revisions were made to the inventor's draft application to produce the final Japanese patent application, the essential elements referred to above with regard to conception of the invention were not changed. Thus the Japanese patent application is a constructive reduction to practice of the subject matter contained in the inventor's draft application.

<u>The present application does not claim the same invention as Vargas</u>

A brief review of Vargas shows that the Vargas claims (*e.g.*, claim 1) are directed to a system that allows sellers to register seller information, allows buyers to register buyer

information, and serves as a communication medium between buyers and sellers, whereby sellers decide which buyers can obtain their registered information. Vargas does not claim a system where a merger and acquisition brokering business entity terminal generates a merger or acquisition proposal based on non-public business information provided by candidate enterprise terminals.

<u>Even if Vargas qualifies as prior art, it does not teach the features presently claimed</u>

Independent claim 10 specifies a merger and acquisition brokering business entity terminal having the following features that it is "configured to **generate a merger or acquisition proposal** based on said non-public business information, said merger or acquisition proposal being a proposal that **specifies terms for a merger or an acquisition** related to said candidate enterprise."

These features are not taught by Vargas. Vargas teaches a host computer that receives confidential business information from potential sellers of companies, and receives profiles of potential buyers (par. 20-23). The host computer can "identify matching opportunities" by screening information provided by buyers and sellers to "identify buyers and sellers have overlapping indications" (par. 23). Matches are made known to the buyer and the seller on their respective home pages (par. 23, 35).

Vargas does not have a merger and acquisition brokering business entity terminal that is configured to generate a **merger or acquisition proposal**. Vargas merely finds matches between potential sellers of companies and potential buyers of companies. There is no generation of a merger or acquisition proposal in the Vargas system. At most, Vargas can generate an "indication of interest" (par. 40), and standard paragraphs for a "letter of intent" (par. 41). Neither an indication of interest or a letter of intent constitutes a merger or acquisition proposal, since neither **"specifies terms for a merger or an acquisition."**

The official action states that these features are met by Vargas at par. 23 which discusses matching opportunities. This is not correct, since matching opportunities simply indicates "buyers and sellers that have overlapping indications" and do not specify terms for a merger or an acquisition. Further, claim 10 specifies that he generation of a merger or acquisition proposal occurs at a merger and acquisition brokering business entity terminal.

The determination of matching opportunities in Vargas occurs at a host computer, further showing that Vargas does not possess the features required by claim 10.

Independent claims 16 and 23, and the dependent claims of the application, involve similar features and are distinguished on the same basis.

Conclusion:

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date ____March 6, 2007____   By _____

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